

### **REMARKS**

By this response, claims 21-24, 27-29, 32-34, and 36-40 are pending. Compared to the immediately prior version of the claims, independent claims 21 and 32 are amended, as are their dependent claims 22-24, 27, 33, 34 and 36. Also, claims 1-20, 25, 26, 30, 31, 35, and 41 remain canceled, while all others remain as previously presented.

The Examiner has allowed claims 28-29 and 37-40, *7-9-08 Office Action*, p. 2, 3<sup>rd</sup> ¶, and the Applicant notes and appreciates it. The Examiner has, however, rejected claims 21-24, 27, 32-34, and 36 under 35 U.S.C. § 101 “because both claims 21 and 32 are directed to a ‘computer system.’” *7-9-08 Office Action*, p. 2, 4<sup>th</sup> ¶. Also, the Examiner contends that claims 21 and 32 “are lacking a piece of hardware or physical object to implement the steps or processes in their bodies claimed limitation.” *Id.* The Applicant respectfully requests reconsideration of the rejection of claims 21 and 32, and those claims that depend therefrom. Also, the Examiner has summarized these rejections in his Interview Summary in the context of a communication with the undersigned representative on July 9, 2008. The undersigned representative agrees with his comments, but adds that the same section 101 rejections have been earlier made and overcome regarding these claims. By re-presenting the rejections here, they undid an agreement with the Examiner and his supervisor regarding a Notice of Allowance.

As before, the law defines four categories of inventions, e.g., processes, machines, manufactures and compositions of matter. As mentioned under *MPEP* §2106, for example, the latter three categories define “things” or “products,” while the first category, “processes,” define “‘actions’ (i.e., inventions that consist of a series of steps or acts to be performed.)” Also, the U.S. Supreme Court has interpreted 35 U.S.C. §101 as broadly including “anything under the sun that is made by man.” *Diamond v. Chakrabarty*, 447 US 303, 308-309, 206 USPQ 193, 197 (1980). Despite the seeming breadth of such an interpretation, it is more narrowly anything under the sun, made by man, other than the “laws of nature, natural phenomena, and abstract ideas.” *Diamond v. Diehr*, 450 US 175, 185 (1981). The ultimate issue must also be dissected according to “whether the claim *as a whole* is drawn to statutory subject matter.” *Emphasis*

added, *AT&T Corp. v. Excel Communications Inc.*, 50 USPQ2d 1447, 1451 (Fed. Cir. 1999) (citing to *In re Alappat*, 33 F3d. 526, 31 USPQ2d 1545 (Fed. Cir. 1994), among other cites.).

However, in independent claims 21 and 32, nothing realistically can be construed as a law of nature, a natural phenomena or an abstract idea. Rather, the invention of amended independent claims 21 and 32, as a whole, requires a “computer program product ... having computer executable instructions for loading on a computing device” including a structural “directory shell” having both “an administrator utility” and “a directory browser.” In addition, claims 22 and 32 include a structural “directory shell” for *loading on said computing device* that, in turn, is in communication with multiple servers. In other words, structural components, such as the “directory shell,” which can be loaded on a structurally tangible machine, such as a computer, implement the processes of the claims.<sup>1</sup>

Further, the Applicant submits that in accordance with M.P.E.P. § 2106, claims 21 and 32 are practical applications that produce useful, concrete, and tangible results. For example, the claims include “associat[ing] the directory class in the one of the directories to the directory class in the another of the directories, the result of associating the directory classes being a user-searchable category” while the browser provides a structure “whereby users can search the directory classes of the two or more disparate directories with a single query of the user-searchable category.” Claim 32 even provides for “a table” to enable the associating of disparate directory classes and “a query portion” and “a panel” in the browser to actually conduct the search and view the results, respectively. In other words, the result, in addition to the implementation of the processes, is also structurally tangible. Further, the result is useful in that computer searching of dissimilar directories is now made convenient, not only to users, but also

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<sup>1</sup> See also, *M.P.E.P. § 2106.01*, citing *Lowry*, 32 F.3d at 1583-84, 32 USPQ2d at 1035, “a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program’s functionality to be realized, *and is thus statutory*.”

to administrators responsible for associating the two or more disparate directories. For at least these reasons, the Applicant submits that claims 21 and 32 contain statutory, structural implementations of the processes in the claims and respectfully requests a reversal of the rejection under 35 U.S.C. § 101. Those claims that depend therefrom, i.e., claims 22-24, 27, 33, 34 and 36 are submitted as allowable for the same reasons and also have their preambles amended to reflect their nature of being a “computer program product.”

In addition, in *Ex Parte Oleg Wasynczuk*, the Board of Patent Appeals and Interferences **concluded that a claim reciting that a first step performed on “a first physical computing device” and a second step performed on “a second physical computing device” sufficiently included statutory subject matter in “‘a particular apparatus’ to which the process is tied, not simply a generic computing device for performing the steps.”** *Ex Parte Oleg Wasynczuk*, Appeal 2008-1496, Application 09/884,528, p. 22 (B.P.A.I. 2008) (emphasis added). As in *Ex Parte Oleg Wasynczuk*, the claims here now all require structures, e.g., directory shells, browsers, etc., tied directly to a first computing device, namely “for loading” on a computer, and such ties in some instances to one or more other computing devices, i.e., servers. Thus, precedent dictates that the claims herein are statutory subject matter.

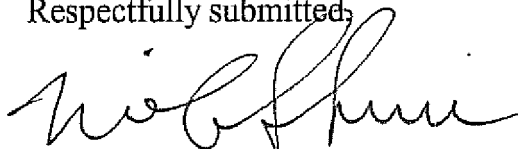
In *Ex Parte Guang-Ho Cha*, a claim recited a “computer program product including a program of instructions” and “computer readable code means.” *Ex Parte Guang-Ho Cha*, Appeal 2006-3395, Application 09/512,949, p. 3 (B.P.A.I. 2007). Also, the specification in *Ex Parte Guang-Ho Cha* recited “computer-executable instructions that may be contained on a data storage device with a computer readable medium, such as a computer diskette, random access memory of the computer, or various other storage devices.” *Id.* As the Board of Patent Appeals and Interferences explained, claims of this type “require[] more than software per se, but also structure.” *Id.* at p. 4. The Board also stated that the claim “and its depending claims require, at the least, computer-executable code embodied in a tangible medium, notwithstanding how the preamble might be interpreted if divorced from the remainder of the claim.” *Id.*

In line with this rationale, claims 21 and 32 (and their dependent claims) each require a

“computer program product available on a computer readable medium or available as a download having computer executable instructions for loading on a computing device,” which the Applicant submits is more than software per se. First, as explained above, the invention of independent claims 21 and 32, as a whole, requires a “computer program product ... having executable instructions” including a *structural* “directory shell” having both “an administrator utility” and “a directory browser.” Second, as the Applicant’s Specification explains, a “computer 30 can receive data and instructions to operate computer 30 (often referred to as programs or applications) in a variety of different ways,” and “computer readable medium can take a variety of forms, including magnetic storage (such as hard disk drives, floppy diskettes, etc.), optical storage (such as laser discs “LD”, compact discs “CD”, digital versatile discs “DVD”, etc.), electronic storage (such as random access memory “RAM”, read only memory “ROM”, programmable read only memory “PROM”, flash memory, etc.), and the like. *Specification, p. 7, ll. 6-7, 11-15.* Thus, as in *Ex Parte Guang-Ho Cha*, the claimed “computer program product” can take the form of a variety of structural devices, such as a CD or a floppy diskette, and the claims meet the strictures of 35 U.S.C. § 101.

Finally, the Applicant submits all claims stand in a condition for allowance and requests a timely Notice of Allowance to be issued for same. *If any additional fees are due, although none are believed due, the undersigned authorizes their deduction from Deposit Account No. 11-0978.*

Respectfully submitted,



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